REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Applicants respectfully disagree with the finality of the present Office Action. MPEP 706.07(a) states, "second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)." In the present case, the new ground of rejection is neither necessitated by Applicant's amendment of the claims, nor based on information submitted in an information disclosure statement. Hence, it is respectfully requested that the finality of the Office Action be removed.

The Office Action alleges that the claim amendment made in Applicant's response dated October 24, 2008 is not disclosed in paragraphs [0045] and [0050] of the specification, but rather is disclosed in paragraphs [0049] and [0056] of the specification. Applicants disagree in part. The text from the specification quoted on page 2 of the Office Action (i.e., "In an exemplary embodiment, when a consumer sets the bid threshold, the consumer will be able to see an estimate of the number of advertisements that will be sent at that level") is actually from paragraph [0050] on page 34 of the specification. Thus, Applicants and the Office Action are, in fact, referring to the same language from the specification. In addition, Applicants believe that other sections of the specification also support the claim amendment, for example paragraph [0045] on page 33, and possibly [0056] on page 35 of the specification as suggested by the Office Action.

Claims 1-2, 27-29, 31 and 35 have been amended such that various steps of these claims recite "a personal device of the user". These amendments are supported by the specification as originally filed, for example at paragraph [0032] on pages 29-30 and figure 2a of the specification. No new matter is being added by any of the present amendments.

Claims 1-12, 15-29, 31-38 and 40-43 are patentable under 35 U.S.C. §101.

As stated in recent Federal Circuit decisions, a process is patentable under 35 U.S.C. §101 if the process is tied to a particular machine or apparatus. *In re Bilski, 88 USPQ2d 1385 (Fed. Cir. 2008)*, page 10. Claim 1, as amended, is directed to a process that is tied to an apparatus, such as a

personal device of the user. Thus, claim 1 is patentable under 35 U.S.C. §101. Claims 2 and 35, as amended, recite features similar to those recited in claim 1. Therefore, claims 2 and 35, and their respective dependent claims, are likewise patentable under 35 U.S.C. §101.

The Office Action alleges that "[t]o be statutory, each claim limitation (each step) should be performed using a 'particular machine' (In re Bilski, 88 USPQ2d 1385 (Decided October 30, 2008))". Applicants disagree. In fact, *In re Bilski* states, "... it is inappropriate to determine the patent-eligibility of a claim as a whole based on whether selected limitations constitute patent-eligible subject matter". *In re Bilski, 88 USPQ2d 1385 (Fed. Cir. 2008)*, pages 17-18, emphasis added. Similarly, *In re Bilski* states, "... it is irrelevant that any individual step or limitation of such processes by itself would be unpatentable under § 101". It follows from *In re Bilski* that it is not necessary for every (i.e., each) limitation to be performed using a particular machine, for the claim as a whole to be patentable under 35 U.S.C. §101. Further, it is noted that *In re Bilski* does not require limitations to be performed using a particular machine, only that limitations be "tied to a particular machine or apparatus". *In re Bilski, 88 USPQ2d 1385 (Fed. Cir. 2008)*, page 10.

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Respectfully submitted,
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